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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,110	01/25/2000	Frank W. Liebenow	450.129US2	8106

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EXAMINER

ALPHONSE, FRITZ

ART UNIT PAPER NUMBER

2133

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/491,110

Applicant(s)

LIEBENOW, FRANK W.

Examiner

Fritz Alphonse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32-38 and 40-51 is/are allowed.
- 6) ☒ Claim(s) 30,31 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 0200 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/23/2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

0.1 This office action is in response to amendment filed on 6/23/2004. Claims 30-51 are pending.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.3218 may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 39 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,078,312. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 39 of the present application recites the patented limitations of claims 1-12 of U.S. Patent No. 6,078,312, except for the limitation "a plurality of uniquely coded positions" which is included in the claims.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the elements of the present application since the addition of the limitation, as indicated above, would provide a much more specific subject matter. However,

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this would not have changed the process according to which functional differences are compensated for a simply structured pointing device that has high performance and reliability.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joyce in view of Victor (U.S. Pat. No. 4,751,380).

As to claims 30-31, Joyce (figs. 1-3) show a computerized system comprising: a computer (48) having at least a processor (40) and a memory (42); and, a mouse pointing device (10) positionable over a surface (col. 2, lines 64-66).

Joyce does not explicitly teaches “a surface having a plurality of uniquely coded positions arranged in a gradient and a mouse that senses the coding of the uniquely coded position underneath the mouse and conveying to the computer information relative to the uniquely coded position underneath the mouse.” However, the limitations are clearly disclosed by Victor (see abstract; col. 4, lines 46-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Kirsch with the cursor position control system, as disclosed by

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Victor. Doing so would provide a compact optical mouse, which determine relative motion between the mouse and the grid regardless of their relative positions.

Allowable Subject Matter

5. Claims 32-38, 40-51 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Claims 32, 40 and 51 are indicated to contain allowable subject matter because the prior art of record does not disclose or make obvious the limitations “a fixed first sensor positioned over the first gradient to detect the intensity level of the position underneath the first sensor; a fixed second sensor positioned over the second gradient to detect the intensity level of the position underneath the second sensor.”

Claims 34, 36 and 38 are indicated to contain allowable subject matter because the prior art of record does not disclose or make obvious the limitations “a first sensor positioned under the bottom surface of the dome to detect the intensity level of the first color of the position above the first sensor; a second sensor positioned over the bottom surface of the dome to detect the intensity level of the second color of the position above the second sensor.”

Claims 33, 35, 37, 41-50 are allowable by virtue of dependency.

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Response to Arguments

6. Applicant's arguments with respect to claims 30-51 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington, D.C. 20231

or faxed to: (703) 872-9306 for all formal communications.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fritz Alphonse, whose telephone number is (571) 272-3813. The examiner can normally be reached on M-F, 8:30-6:00, Alt. Mondays off.

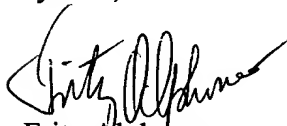
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert De Cady, can be reached at (571) 272-3819.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may also be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Fritz Alphonse

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August 17, 2005



GUY LAMARRE
PRIMARY EXAMINER